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10/768,034	01/30/2004	Kevin Dawson	010023-001710US	8080

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PALO ALTO, CA 94303

EXAMINER

LU, CHARLES EDWARD

ART UNIT	PAPER NUMBER
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2161

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/768,034	Applicant(s) DAWSON, KEVIN	
	Examiner Charles E. Lu	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/1/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment/Response to Arguments

1. This Action is in response to the Amendment dated 1/8/2007. Claims 1-16 and 24-26 are pending. Claims 1-16 and 24-26 are rejected.
2. Amendments to the specification are noted. The objection to the specification is withdrawn.
3. Amendments to the claims and remarks addressing the 35 U.S.C. 101 rejections are noted. The 35 U.S.C. 101 rejections of claims 1-16 and 24-25 are withdrawn. The rejection for claim 26 is maintained. See below.
4. Amendments to the claims addressing the 35 U.S.C. 112, second paragraph rejections are noted. The 35 U.S.C. 112, second paragraph rejections of the claims are withdrawn.
5. Arguments regarding the 35 U.S.C. 103(a) rejections have been fully considered but are not persuasive.

As to the argument on p. 8, second paragraph of the Amendment stating that Turnbull does not teach or make obvious limitations (ii) and (iii), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the previous Action, it is noted that a combination of references was used to make limitations (ii) and (iii) obvious.

On p. 8, third paragraph, Applicant state that fig. 4 and para. 60-62 of Turnbull deals with web page browsing and not document searching. The examiner respectfully disagrees. Turnbull at fig. 4 and para. 60-62 at least deals with web page browsing as well as document searching (see e.g., content links, #88 and search box #66). Applicant further states that the content is not organized by occurrence of names within documents, but the examiner recognizes that the rejection was made based on a combination of references, which teaches or suggests the claimed subject matter. See above.

On p. 8, fourth paragraph, Applicant argues the claims as amended, and the amended claims are addressed below.

Applicant's amendments to the claims change the scope of the invention and necessitate the new grounds of rejection presented below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 26 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 26, the specification (e.g., para. 91) appears to list a machine-readable medium as a signal. Therefore, claim 26 embodies a signal, which is not a statutory category of invention (i.e., process, machine, manufacture, composition of matter) because a signal is a form of energy. Also see previous Action.

Art rejection is applied in anticipation of Applicant amending the claims to overcome the rejection under 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-16 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turnbull et al of record (US 2002/0103789) in view of Tso et al (US 6385602).

As to claim 1, Turnbull teaches the following claimed subject matter:

System including a user input device and user output device (fig. 1, #20, fig. 4);

Accepting first (fig. 4, #66) and second (fig. 4, #80) search terms from user input device, the second term (#80) associated with a predetermined list of two or more names (#82);

Identifying documents from the database the satisfy the first search term (para. 0088);

Determining an occurrence of the names in the identified documents (#82, para, 0060-0063);

Presenting at least a portion of the identified documents to a user by using the output device (fig. 1, #20, fig. 4) wherein the presented identified documents are

ordered according to the names (fig. 4, #82, 86, related text).

Turnbull does not expressly teach "frequency of occurrence of names within identified documents."

However, Tso teaches determining a frequency of occurrence of a category name (col. 5, ll. 35-59, fig. 3C, col. 8, ll. 60-67) within identified documents. Turnbull discloses various names or categories (#82) for facilitating browsing various found documents (see Turnbull).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Turnbull with the above teaching of Tso, such that the names (Turnbull, #82) are additionally presented according to frequency of occurrence of a category name such as in Tso, fig. 3C. The motivation would have been to help the user in determining which category he or she might want to choose, as taught by Tso (col. 8, ll. 65-67).

Turnbull and Tso as applied above do not expressly teach "ordering" according to the determined frequency of occurrence of the names within the identified documents.

However, as discussed above, Turnbull provides a user interface with a category name listing (e.g., fig. 4). Tso discloses listing the number of hit counts next to the category (see fig. 3C), and calculating a frequency of occurrence of names within identified documents (see above). Tso in the combination further suggests ordering (e.g., in decreasing order) according to the frequency of occurrence because Tso teaches (i), search results are presented in a sequential list of matching data items ranked by relevance in decreasing order (col. 1, ll. 40-50). (ii) qualifying data items are

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sorted by one or more attributes to generate sorted search results (col. 5, ll. 39-41), (iii) categories within a group may be presented to users in any order, and some orderings may be preferable to others (col. 7, ll. 50-54), and (iv) category relevance may be calculated in any number of ways (col. 7, ll. 59-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Turnbull and Tso with the above, such that the results are listed in decreasing order of the number of hits. The motivation would have been to further facilitate helping the user in determining which category he or she might want to choose, as taught by Tso (col. 8, ll. 65-67), since categories within a group may be presented to users in any order, and some orderings may be preferable to others (col. 7, ll. 50-54).

As to claim 2, Turnbull, as applied above, further teaches wherein the predetermined list of names (#82) is created at least in part by receiving signals from a user interface (e.g., user interface component in #80);

As to claim 3, Turnbull, as applied above, further teaches wherein the predetermined list of names is created at least in part by receiving signals from a process. This must happen for Turnbull to be functional in a computer environment as a browsing and searching system (e.g., see the display on fig. 4);

As to claim 4, Turnbull, as applied above, further teaches wherein the second term is selected from a list of context names (e.g., pull down menu #80);

As to claim 5, Turnbull, as applied above, further teaches wherein identifying documents includes sending a database query to a database server, and receiving

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search results from a database server. This must happen for Turnbull to be functional in a computer environment as a browsing and searching system (e.g., see fig. 1-2 and related text).

As to claim 6, Turnbull, as applied above, further teaches wherein the search results include document identifiers (fig. 4, #86).

As to claim 7, Turnbull, as applied above, further teaches wherein the first search term includes a keyword (para. 0088).

As to claim 8, Turnbull, as applied above, further teaches wherein determining includes searching the identified documents to determine if a name is present in a document (see Turnbull, e.g., fig. 2, para. 0088, Tso, col. 5, ll. 20-60).

As to claim 9, Turnbull, as applied above, further teaches wherein searching includes pre-compiling a list of identifiers for documents in which a name occurs (e.g., the sub-categories is a list of identifiers for documents such as search results, in which a name occurs) and comparing the identified documents with names identified in the pre-compiled list to determine matches (this comparison has to happen for matches #86 to be displayed according to category and sub category #80 and #82).

As to claim 10, Tso, as applied above, further teaches wherein presentation of documents includes listing document identifiers on a display screen in decreasing order of the frequency of occurrence of two or more names. See above discussion of claim 1.

As to claim 11, Tso, as applied above, further teaches ordering a list of the two or more associated names according to a frequency of occurrence of the associated terms in items. See above discussion of claim 1.

As to claim 12, Tso, as applied above, further teaches displaying a number associated with each name to indicate a number of documents in which each name occurs. See discussion above for claim 1 and fig. 3C, #332).

As to claim 13, Turnbull, as applied above, further teaches automatically defining two or more terms associated with the second term. This is seen in the automatic underlining of terms when subcategories corresponding to them are identified (see fig. 4, #84).

As to claim 14, Turnbull, as applied above, further teaches accepting signals from a user input device to define two or more terms associated with the second term (e.g., para. 0066).

As to claim 15 and claim 16, Turnbull, as applied above, does not expressly teach wherein the second term includes the word "genes" and an associated term includes a gene name, or wherein the second term includes the word "regions" and an associated term includes a region name.

However, Turnbull discloses categories, which includes words and associated terms (meeting the limitation of "term" and "associated term", see fig. 7-8) and an interface displaying categories and associated names (see e.g., fig. 4, #80, #82). Turnbull further discloses that the hierarchies are not limited (para. 0065, 0066), the user may establish categories (para. 0066), and the user may search the entire Web (fig. 4, #66).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Turnbull and Tso with the above, such that a

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category for genes and associated names as subcategories, as well as a category for regions and associated names as subcategories, would be implemented within the search system and displayed on the interface of fig. 4 of Turnbull. The motivation would have been to support a user searching on the Web for various items, in this case, content pointers (fig. 4, #86) to gene-related documents, and region-related documents.

Claim 24 is drawn to an apparatus claiming the same invention as claim 1, in addition to a processor coupled to a user input device, a user output device, and a machine readable medium, all of which must be present in Turnbull for successful operation in a computer environment.

As to claims 25-26, see the discussion of claim 24 above.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1-16 and 24-26 of the instant application provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-16 and 24-26 of copending Application No. 10/759,784. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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Conclusion

Applicant's amendment necessitates new grounds of rejection. Applicant's arguments were fully considered but were not persuasive. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Lu whose telephone number is (571) 272-8594. The examiner can normally be reached on 8:30 - 5:00; M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be contacted at (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CL
Assistant Examiner
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2/16/2007

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